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10/796,814

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M. Michael Pitts JR.

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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte M. MICHAEL PITTS, JR. and
RODRIGO F.V. ROMO

Appeal 2007-0417
Application 10/796,814
Technology Center 1700

Decided: November 30, 2007

Before EDWARD C. KIMLIN, CHUNG K. PAK, and
THOMAS A. WALTZ *Administrative Patent Judges*.

PAK, *Administrative Patent Judge*.

ON REQUEST FOR REHEARING1

Pursuant to 37 C.F.R. § 41.52 (2005), Appellants request rehearing of our Decision entered May 11, 2007, wherein we affirmed the rejection of claims 1 through 3 under 35 U.S.C. § 102(b) as anticipated by the disclosure of Pitts. *See* Request for Rehearing 1-5.

The Appellants contend that the present application is entitled to the benefit of the filing date of Pitts under 35 U.S.C. § 120, thus removing Pitts

as a prior art reference against the claims on appeal. *Id.* In support of this contention, the Appellants appear to argue that the Board erred in determining that the Appellants have not demonstrated that each and every application in the priority chain inherently describes the subject matter claimed in the above-identified application. *See* Request for Rehearing 2-5. We do not agree.

As stated at page 4 of our Decision entered May 11, 2007, the Examiner has determined that the present application is not entitled to the benefit of the filing date of Pitts. In support of this determination, the Examiner has found that "[Pitts] and the other applications in the priority chain do not expressly describe reducing the formation of biofilm deposits within the meaning of 35 U.S.C. § 112, first paragraph (Answer 4)." *See* page 4 of our decision. The Appellants have not challenged this factual finding. *See* Br. and Reply Br. in their entirety. Rather, the Appellants only argue (Br. 5) that:

No case law or statutory authority standing for the proposition that an applicant's parent application itself can be used to anticipate a child application was cited by the Examiner. Instead, the Examiner relies solely upon MPEP 2133.01 ("Rejections of Continuation-in-Part (CIP) Application"). The Examiner then goes on to explain that, on the one hand, "the ['317 Patent] does not disclose a method for reducing the formation of biofilm deposits on a wall in a water system," yet, on the other hand, "The use of the electrostatic-field generator disclosed and claimed in the '317 Patent is considered to inherently result in reducing the formation of biofilm deposits" (see paragraphs 4 and 5 of the Office Action dated 11/16/2005). In other words, the Examiner states that the '317 Patent inherently discloses the claims under appeal for prior art purposes but not for priority purposes. Aside from being directly contrary to the language 35 U.S.C. 120 for the granted

priority claim, the selective application by the Examiner of "inherent disclosure" to find anticipation yet deny priority has no basis in patent law.

In spite of the Examiner's assertions directed to both Pitts and the other applications in the priority chain, the Appellants have limited their arguments to Pitts only. Compare Ans. 4 with Br. 4-6 and Request for Rehearing 3. The Appellants have not presented any evidence, much less any arguments, that all of the applications in the priority chain expressly, implicitly or inherently describe reducing the formation of biofilm deposits as recited in the claims on appeal. *See* Br. in its entirety.

It is well established that "[i]n order to gain the benefit of the filing date of an earlier application under 35 U.S.C. § 120, each application in the chain leading back to the earlier application must comply with the written description requirement of 35 U.S.C. § 112." *Lockwood v. Am. Airlines, Inc.*, 107 F.3d 1565, 1571 (Fed. Cir. 1997). Consistent with this well established legal principle, our decision stated (pp. 5-6) that:

[I]n order for the present application to be entitled under 35 U.S.C. § 120 to the filing date of Pitts in the chain of applications of which it is a part, "it must be shown that as to the inventions claimed there has been [a] 'continuing disclosure through the chain of applications, without hiatus.'" *Lemelson v. TRW, Inc.*, 760 F.2d 1254, 1266, 225 USPQ 697, 706 (Fed. Cir. 1985)(citation omitted). In other words, the Appellants have the burden of establishing that each application in the chain either inherently, implicitly or expressly provides written descriptive support for the claimed subject matter of the present application within the meaning of 35 U.S.C. § 112, first paragraph, in order to obtain the filing date of Pitts. *See also In re Ziegler*, 992 F.2d 1197, 1200, 26 USPQ2d 1600, 1603 (Fed. Cir. 1993) (The burden of establishing entitlement to the filing date of a previously filed foreign application is on the applicant.); *Langer v. Kaufman*, 465 F.2d 915, 913, 175 USPQ

172, 174 (CCPA 1972) (“To prove inherency, the burden is on appellants to show that the ‘necessary and only reasonable construction to be given the disclosure by one skilled in the art is one which will lend clear support to....[this] positive limitation...”).

However, as indicated *supra*, the Appellants have not discussed any intervening applications in the priority chain to meet the requirements of 35 U.S.C. § 120. Accordingly, we find no reversible error in our Decision for holding that the Appellants fail to carry their burden under 35 U.S.C. § 120.

The Appellants for the first time argue that the intervening applications in the chain have written descriptive support for the subject matter claimed in the present application. *See* the Request for Rehearing 2-5. Manifestly, however, we could not have misapprehended and overlooked what was not before us at the time our Decision was rendered. 37 C.F.R. § 41.52(a)(1) (“The request for rehearing must state with particularity the points believed to have been misapprehended or overlooked by the Board.”). Moreover, the Appellants have not presented any good cause for belatedly providing this argument for our consideration. *See* 37 C.F.R. § 41.52 (a)(2). Accordingly, we decline to consider this argument.

To the extent that we must consider this argument, we still find that the subject matter claimed in the present application is not shown to be inherently described in the intervening applications. Specifically, we find that the Appellants have not demonstrated that the intervening applications in question describe employing the claimed apparatus, conditions, and parameters in a water system so as to inherently reduce biofilm deposits as explained at pages 3 and 4 of our Decision. Mere arguments in the Brief or

the Request for Rehearing cannot take the place of objective evidence. *In re De Blauwe*, 736 F.2d 699, 705 (Fed. Cir. 1984).

The Appellants contend that the Board overlooked the Appellants' reference to all the priority applications in the chain in the Specification. *See* Request for Rehearing 1-5. This contention is directed to *dictum* at page 7 of our Decision which states in relevant part:

In addition to the written description requirement under § 112, the statute also requires the present application to provide "a specific reference" to an earlier application. In other words, the present application needs to refer to all the applications in chain, including Pitts, if it is to obtain the benefit of the filing date of Pitts. *Sticker Indus. Supply Corp. v. Blaw-Knox Co.*, 405 F.2d 90, 92-93, 160 USPQ 177, 178-79 (7th Cir. 1968). However, the Appellants' present application states in the "CROSS-REFERENCE TO RELATED APPLICATIONS" section (Specification 1) that:

This application is a continuation application of copending U.S. Serial No. 10/047,493, filed January 14, 2002, which was a CIP application of U.S. Ser. No. 09/416,255, filed October 12, 1999, abandoned.

The present application does not refer to the other applications in the priority chain, including Pitts. Thus, even if the subject matter claimed in the present application is described by the chain of applications, we determine that the present application is, at best, entitled to the filing date of Application 09/416,255 (October 12, 1999). *See Sticker Indus. Supply Corp. v. Blaw-Knox Co.*, *supra*. Inasmuch as Pitts' publication or issuance date is still more than one year before the filing date of Application 09/416,255, the Appellants cannot remove Pitts as a prior art reference against the claims on appeal.

Appeal 2007-0417
Application 10/796,814

We have supplied this *dictum* to assist the Appellants in the event of further prosecution of the subject matter claimed in the present application. In so doing, we have inadvertently overlooked that the Appellants have submitted a petition to cure this deficiency during the prosecution. However, this inadvertent mistake is harmless and does not affect the outcome of our Decision.

Accordingly, the Appellants' request for rehearing is granted to the extent indicated above, BUT IS DENIED WITH RESPECT TO MAKING ANY CHANGES TO THE OUTCOME of our Decision.

REQUEST FOR REHEARING-MODIFIED/DENIED

tf/ljs

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